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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

107348-00393

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Typed or printed name _____

Application Number

10/784,891

Filed

February 24, 2004

First Named Inventor

Nemoto HIROTOMI

Art Unit

3632

Examiner

Todd M. EPPS

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 52,763☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Michele L. Connell

Typed or printed name

202 857-6000

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Confirmation No.: 9987

Nemoto HIROTOMI

Art Unit: 3632

Serial No.: 10/784,891

Examiner: Todd M. Epps

Filed: February 24, 2004

Docket No.: 107348-00393

For: ANTI-VIBRATION SUPPORT SYSTEM FOR ENGINE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

April 19, 2006

Sir:

The Applicant requests review of the Office Action mailed January 20, 2006, in the patent application identified above. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

REMARKS

Claims 1-20 are pending in the subject application. The outstanding Office Action is a Final Office Action. Thus, the application qualifies for Appeal.

In the outstanding Office Action, the Examiner rejected claims 1-10 and 11-20 under 35 U.S.C. § 102(b) as being anticipated by Nemoto et al. (U.S. Patent No. 6,422,546 B1, hereinafter "Nemoto").

The Applicant submits that these rejections are made in error for at least the reasons set forth below.

I. Omission of Essential Elements Needed for *Prima Facie* Rejection

In the outstanding Office Action, the Examiner has cited a reference that does not meet all of the claimed limitations.

Under U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "Every element of the claimed invention must be arranged as in the claim . . . the identical invention, specifically, [t]he identical invention must be shown in as complete detail as contained in the claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The following comments set forth the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

Independent claim 1 of the subject application recites, in part:

wherein operation of said active anti-vibration supporting device is prohibited when an abnormality in an operational state of the engine is detected...

Independent claim 11 of the subject application recites, in part:

wherein the cylinder suspension of the engine is prohibited when an abnormality in an operational state of said active anti-vibration supporting device is detected...

As noted above, in the outstanding Office Action, the Examiner rejected independent claims 1 and 11 under 35 U.S.C. § 102(b) as being anticipated by Nemoto et al. (U.S. Patent No. Nemoto).

In making this rejection, the Office Action asserts that Nemoto discloses all of the elements of claims 1-10 and 11-20, including the elements cited above. The Office Action asserts that Nemoto discloses the elements of independent claims 1 and 11 cited above in "Figs. 1-9." See lines 5-7 of the third paragraph of page 2, and lines 12-14 of page 3, of the outstanding Office Action. However, upon extensive review of the Nemoto reference, the Applicant is unable to find any disclosure within Nemoto to support the allegation that Nemoto discloses the aforementioned elements in "Figs. 1-9." In response to the Office Action mailed August 9, 2005, which also asserted that the elements of claims 1 and 11 cited above are disclosed in Figs. 1-9 of Nemoto, the Applicant submitted that Nemoto does not disclose, within Figs. 1-9 or elsewhere, prohibiting operation of an active anti-vibration supporting device when an abnormality in an operational state of the engine is detected, as recited in claim 1. Moreover, the Applicant submitted that Nemoto does not disclose, within Figs. 1-9 or elsewhere, prohibiting operation of the cylinder suspension of the engine when an abnormality in an operational state of said active anti-vibration supporting device is detected, as recited in claim 11. See page 2 of the November 9, 2005, Response.

In response to the Applicants Remarks submitted in the November 9, 2005, Response, the Examiner asserted:

In general, when an abnormality in an operational state of the engine is detected, a sensor or a human can turn off the operation of an active anti-vibration supporting device manually. In this case, when the device is not running smooth, a human can do the operation by turning off the key ignition with a switch or automation program. The Applicant did not specify the operation is a sensor, which has the capability of shutting off the device and the engine.

Office Action of January 20, 2006, at p. 4.

However, as noted above, claim 1 recites “wherein operation of said active anti-vibration supporting device is prohibited when an abnormality in an operational state of the engine is detected...” Claim 1 does not recite turning off the ignition.

Furthermore, Nemoto does not even mention detecting an abnormality in an operational state of an engine. Thus, Nemoto cannot and does not disclose or suggest at least the element of prohibiting operation of an active anti-vibration supporting device when an abnormality in an operational state of the engine is detected, as recited in claim 1.

Claim 11 recites “wherein the cylinder suspension of the engine is prohibited when an abnormality in an operational state of said active anti-vibration supporting device is detected...” Claim 11 does not recite turning off the ignition.

Moreover, Nemoto does not disclose or suggest detecting an abnormality in an operational state of an active anti-vibration supporting device. Thus, Nemoto does not disclose or suggest at least the element of prohibiting cylinder suspension of the engine when an abnormality in an operational state of an active anti-vibration supporting device is detected, as recited in claim 11.

Given the complete absence of any teaching or suggestion in Nemoto directed to the claimed elements cited above, the Applicant submits that the reasons for rejection asserted in the outstanding Office Action are improper as they are based on erroneous facts.

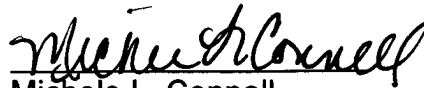
As such, the Applicant respectfully submits that the Office Action’s assertion that Nemoto discloses, let alone suggests, the aforementioned elements is an error based upon a clear factual deficiency in the rejection, and not a matter of interpretation. For at least this reason, the Applicant respectfully submits that the rejections based on Nemoto are factually erroneous and therefore improper, and withdrawal of such rejections is requested.

II. Conclusion

For all of the above reasons, review of the outstanding Office Action is respectfully requested, and a favorable decision, and allowance of all pending claims, are earnestly solicited.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Docket No. 107348-00393.**

Respectfully submitted,
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Enclosures: Notice of Appeal to the BPAI
Pre-Appeal Brief Request for Review (Form PTO/SB/33)